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In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

IN THE MATTER OF THE APPLICATION OF FREDERICK C. FOSTER, PETITIONER

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

Both the original decision of the Patent Office Board of Appeals (App. 65a–70a)[1] and its decision on reconsideration (App. 71a–73a) are unreported. The opinion of the United States Court of Customs and Patent Appeals is reported at 343 F. 2d 980 (App. 5a–41a).

JURISDICTION

The opinion of the Court of Customs and Patent Appeals was entered April 15, 1965 (App. 5a). A timely petition for rehearing or reconsideration was denied on July 1, 1965 (App. 42a). The petition for a writ of certiorari was filed July 14, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

[1] "App." refers to the Appendix filed as a separate document with the Petition. "Pet." refers to the Petition.

QUESTION PRESENTED

Section 103 of the Patent Act provides, as a condition of patentability, that an invention is not patentable if, at the time it was made, it was "obvious" to "one skill[ed] in the art." Where there is a delay between the invention and the patent application, Section 102(b) of the Patent Act (the so-called "time-bar" provision) provides in addition that the right to a patent is lost if the invention "was patented or described in a printed publication * * * more than one year prior to the date of application for patent * * *." The question presented is whether this time-bar provision applies where a printed publication, subsequent to the invention but more than one year prior to the patent application, does not identically disclose the invention upon which a patent is later applied for but renders it obvious to one skilled in the art.

STATUTES INVOLVED

35 U.S.C. 102, in relevant part, provides:

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * *

35 U.S.C. 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 132 provides:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

35 U.S.C. 144 provides:

> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall

be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

STATEMENT

Petitioner filed his patent application for "Butadiene Polymers and Copolymers Thereof"[2] on August 21, 1956 (App. 5a). The date of invention was prior to December 26, 1952 (App. 14a). The only prior art reference relevant to petitioner's application was an article by Binder in the magazine "Industrial and Engineering Chemistry" (Vol. 46, No. 8, pp. 1727–1730), which was published in August, 1954 (App. 9a). Thus the Binder reference was published after the date of petitioner's invention but more than one year before his patent application.

The Examiner either rejected or refused to allow all of the claims of the application and the Board of Appeals affirmed (App. 65a–70a; 71a–73a). On petitioner's appeal to the Court of Customs and Patent Appeals, the decision of the Board of Appeals as to seven of the claims was reversed but the rejection of ten of the claims was affirmed "because the [petitioner] has lost his right to these claims" (App. 26a). With regard to these claims, the court ruled that while the Binder reference did not contain

[2] The subject matter to which the application relates is a new kind of synthetic rubber (Pet. 4). None of the details of the application are relevant to the questions raised by the petition.

an identical disclosure of petitioner's invention (App. 13a), the invention had become "obvious to the public at the time of the Binder publication" such that, under Section 103 of the Patent Act (35 U.S.C. 103), there would not have been a patentable invention had the Binder publication preceded the invention (App. 23a). The court therefore applied the time-bar provision of Section 102(b) of the Act (35 U.S.C. 102(b)) which provides that the right to a patent is lost if the invention "was patented or described in a printed publication * * * more than one year prior to the date of application for patent * * *."

ARGUMENT

The decision of the Court of Customs and Patent Appeals is correct and fully effectuates the purpose of Section 102(b). There is no conflict with the decisions of any other court. There is therefore no occasion for review by this Court.

1. Before considering the issues raised in the petition, we note that there is currently pending before this Court the issue of whether certiorari jurisdiction exists under 28 U.S.C. 1256 to review decisions of the Court of Customs and Patent Appeals in cases on appeal from the Board of Appeals of the Patent Office. *Brenner* v. *Manson*, No. 58, October Term, 1965. While we suggest in that case that jurisdiction does exist, we submit that, should the Court agree with petitioner that the issues raised in the petition call for this Court's review, disposition of the petition should nevertheless be held in abeyance pending a decision on the jurisdictional issue in *Manson*. If, on the other hand, the Court

believes, as we urge, that review of the decision below is unwarranted, then the petition should be denied.

2. Section 102(b) of the Patent Act (35 U.S.C. 102(b)) deals with the loss of right to a patent through events subsequent to invention where the application for patent is delayed. It provides that the right to a patent shall be lost if "the invention was patented or described in a printed publication * * * or in public use * * * more than one year prior to the date of the application for patent in the United States * * *." In one form or another, this provision has been part of the patent law since 1897.[3] Prior to 1939 the statutory bar applied if the subsequent publication appeared within two years of the date of the patent application; in 1939 the period was reduced to one year, thus increasing the scope of the bar.[4]

Petitioner concedes that the time bar applies if the disclosure prior to the patent application is of the *identical* invention contained in the patent, but argues that the bar does not apply where the disclosure merely renders the application "obvious" to one "skill[ed] in the art" within the meaning of section 103 of the Act (35 U.S.C. 103), which precludes patents on such obvious developments.

As the court below recognized, however (and as petitioner argued in that court), "Section 102(b) from its earliest beginnings has been and was intended to be directed toward the encouragement of *diligence* in the filing of patent applications and the protection of the public from monopolies on subject matter

[3] Rev. Stat. § 4886 (1878), as amended, Act of March 3, 1897, ch. 391, § 1, 29 Stat. 692.

[4] Act of August 5, 1939, ch. 450, § 1, 53 Stat. 1212.

which had already been fully disclosed to it" (App. 17a) (emphasis in original). It follows that it makes no difference whether the public disclosure prior to the patent application is of the precise invention disclosed in the application, so as totally to destroy the novelty of the application under the standard of Section 101 of the Act (35 U.S.C. 101), or is such that, in light of the knowledge of those skilled in the art, it renders the application obvious and hence unpatentable under the test of Section 103. In either case the reasons for the time-bar apply: Through a lack of the applicant's diligence the invention has fallen below the substantive standards of patentability more than one year before the application. Petitioner offers no argument showing how the decision below was thus not fully in accord with the purpose of the time-bar provision.

The result reached below is also supported by the history of the Act. In reaching its decision, the court below found that under the law prior to the Patent Act of 1952 the statutory time-bar had been the basis for rejecting or invalidating patents not only on the ground that a reference fully disclosed all the details of the invention (*i.e.*, there was an "anticipation"), but also because, in light of the reference, there was "no invention," (*i.e.*, the invention was "obvious" to one "skill[ed] in the art" under the judicial doctrine which was the predecessor of Section 103)[8] (App. 19a–21a). In view of the fact that the Patent Act of 1952 was intended to make no substantive changes in either the time-bar provisions of the law (Pet. 16–17) or the substantive standard of patenta-

[8] See *Hall* v. *Macneale*, 107 U.S. 90, 96; *Smith & Griggs Mfg. Co.* v. *Sprague*, 123 U.S. 249.

bility (H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess., p. 6 (1952)) the court properly concluded that the time-bar provision continues to apply in "obviousness" or "no invention" situations as well as in situations of exact "anticipation."

Nor does the result below conflict with the language of the 1952 Act. Section 103 was enacted to codify the prior judicial doctrine, originating in *Hotchkiss* v. *Greenwood,* 11 How. 248, that an invention is unpatentable if obvious to those skilled in the art. As such it naturally describes the requirements for patentability at the time of invention (as does Section 102(a), the other principal provision describing the novelty requirement of a patentable invention). Section 102(b), on the other hand, has reference to the consequences of a delayed application and hence speaks in reference to the time of the filing of the application. The question of statutory construction is whether an invention is "patented or described" within the meaning of Section 102(b) when it is rendered obvious to one skilled in the art before the delayed application, as well as when it is exactly disclosed. As we have shown, the purpose and history of Section 102(b) clearly indicate that the test of Section 103 was thus incorporated in Section 102(b).[6]

3. There is no conflict with *Bros Inc.* v. *Browning Mfg. Co.,* 317 F. 2d 413 (C.A. 8), as urged by petitioner (Pet. 22–23). The Court of Appeals for the

[6] Petitioner argues (Pet. 21–22) that the construction below would make Section 103 redundant, since if the obviousness test is incorporated in Section 102(b) it must also be incorporated in Section 102(a), where the identical "patented or described" language is used as the touchstone of novelty. Hence petitioner argues that, under the construction below, Section 103 would not

Eighth Circuit fully agreed that Section 103 was not intended to modify or affect the Section 102(b) time bar. There, as here, the argument was advanced that for a subsequent description of an invention to invalidate a patent under Section 102(b), the invention must be identically disclosed or described. There as here the argument was rejected. 317 F. 2d at 417.[7]

4. Finally, petitioner urges that the court below deprived him of procedural due process by relying upon Section 102(b) rather than exclusively upon Section 103 (Pet. 35–40). However, 35 U.S.C. 132 requires only the reasons for rejection of an application—not the precise section or sections of the statute relied upon. The court below found the statements of rejection by the Patent Office sufficient to warrant consideration of both a Section 103 and a Section 102(b) rejection (App. 11a). Petitioner clearly knew that the rejection was based upon a time bar and he asserts no actual prejudice.

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limit the standard of patentability beyond the limitation already incorporated in Section 102(a). To a large extent, however, Section 103 *is* thus substantively redundant. It was enacted to codify the judicial doctrine of obviousness which had been held to be implicit in the statute (in the absence of Section 103) since 1850, and thereby to achieve "uniformity and definiteness" and to "have a stabilizing effect." See H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952). Whatever substantive change was accomplished by Section 103 was designed to eliminate more restrictive tests of invention, inconsistent with the original 1850 test, which may have been assimilated into the law in the years shortly before 1952. See our Brief in No. 55, O.T. 1965, *United States* v. *Adams*, pp. 25–36. It is therefore no obstacle to the construction adopted below that it assumes that the standard of patentable invention would not be more restrictive if the Act contained only Section 102(a) and not Section 103.

[7] Petitioner's contention that a conflict exists in the decisions of the court below (Pet. 28–34) is relevant only as to decisions

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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subsequent to that in the instant case. Petitioner refers to four such decisions: *Application of Ruschig*, 343 F. 2d 965 (April 22, 1965); *Application of Folkers*, 344 F. 2d 967 (May 13, 1965); *Application of Hughes*, 345 F. 2d 184 (May 20, 1965); *Application of Hassler*, decided July 1, 1965 (App. 49a–64a). Petitioner himself concedes that *Folkers* (Pet. 28) and *Hassler* (Pet. 29) follow and reaffirm the principles of the decision in this case, thus relying only upon *Ruschig* and *Hughes* to demonstrate the present existence of a conflict. In *Ruschig*, however, the court held that the rejection could not be sustained on either the ground of an "anticipation" or on that of "obviousness" so that the issue involved here was not reached. *Hughes* similarly did not decide the issue: The court there showed no concern with the date of invention, the date of filing, or the effective date of the reference relied upon, thus demonstrating the irrelevance to the decision of the time-bar provision of Section 102(b).

U.S. GOVERNMENT PRINTING OFFICE: 1965